

# Vinson & Elkins

ATTORNEYS AT LAW

VINSON & ELKINS L.L.P.  
THE WILLARD OFFICE BUILDING  
1455 PENNSYLVANIA AVE., N.W.  
WASHINGTON, D.C. 20004-1008

TELEPHONE (202) 639-6500  
FAX (202) 639-6604

09/486613

430 Rec'd PCT/PTO 29 FEB 2000

WRITER'S TELEPHONE

(202) 639-6585

September 3, 1998

The Assistant Commissioner for Patents  
Washington, DC 20231

## Box PCT

RE: New Application Filed Under the Patent Cooperation Treaty  
Appl. No.: to be assigned  
Filed: herewith  
For: **Noribogaine in the Treatment of Pain  
and Drug Addiction**  
Inventor(s): Deborah C. Mash  
Applicant: NovoNeuron, Inc.  
Atty. Dkt.: NOV550/58000

Sir:

The following documents are forwarded herewith for appropriate action by the United States PCT Receiving Office:

1. PCT International Application Transmittal Letter (1 page);
2. PCT Request (3 pages);
3. General Power of Attorney executed on behalf of NovoNeuron, Inc. by W. Lee Hearn, President (1 page);
4. General Power of Attorney executed by inventor Deborah C. Mash (1 page);
5. PCT Fee Calculation Sheet;

HOUSTON

DALLAS

WASHINGTON, D.C.

AUSTIN

MOSCOW

LONDON

SINGAPORE

6. International Patent Application entitled:

**NORIBOGAINE IN THE TREATMENT OF PAIN  
AND DRUG ADDICTION**

and naming as inventor(s): Deborah C. Mash

the application comprising:

10 pages of Specification (numbered as pages 1-10);  
3 pages of Claims (numbered as pages 11-13);  
a one-page Abstract (numbered as page 14); and  
1 sheet of drawings (numbered 1/1);

7. Our check no. 839584 in the amount of \$3,115.00 representing the filing fees for this application; and
8. Two (2) return post cards.

It is respectfully requested that the attached postpaid postcards be stamped with the international application number, and that they be returned as soon as possible.

The United States PCT Receiving Office is hereby authorized to charge any fee deficiency or credit any overpayment to our Deposit Account Number 22-0365. A duplicate copy of this letter is enclosed.

Respectfully submitted,

VINSON & ELKINS L.L.P.

*Michael A. Sanzo*

Michael A. Sanzo  
Attorney for Applicant  
Registration No. 36,912

MAS:ct  
Enclosures

TRANSMITTAL LETTER TO THE  
UNITED STATES RECEIVING OFFICE

Date	September 3, 1998
International Application	09/486613
Attorney Docket No.	NOV550/58000

I. Certification under 37 CFR 1.10 (if applicable)

430 Rec'd PCT/PTO 29 FEB 2000

Express Mail mailing number
-----------------------------

Date of Deposit
-----------------

I hereby certify that the application/correspondence attached hereto is being deposited with the United States Postal Service "Express Mail Post Office to Addressee" service under 37 CFR 1.10 on the date indicated above and is addressed to Assistant Commissioner for Patents, Washington, D.C. 20231.

Signature of person mailing correspondence
--

Typed or printed name of person mailing correspondence
--

II. ☒ New International Application

TITLE	NORIBOGAINE IN THE TREATMENT OF PAIN AND DRUG ADDICTION
-------	---

Earliest priority date (Day/Month/Year)
4 September 1997

**SCREENING DISCLOSURE INFORMATION:** In order to assist in screening the accompanying international application for purposes of determining whether a license for foreign transmittal should and could be granted and for other purposes, the following information is supplied. (Note: check as many boxes as apply):

- A. ☐ The invention disclosed was **not** made in the United States.
- B. ☐ There is no prior U.S. application relating to this invention.
- C. ☒ The following prior U.S. application(s) contain subject matter which is related to the invention disclosed in the attached international application. (NOTE: priority to these applications may or may not be claimed on form PCT/RO/101 (Request) and this listing does not constitute a claim for priority).

application no.	60/057,921	filed on	4 September 1997
application no.		filed on	

- D. ☐ The present international application ☐ is identical ☐ contains less subject matter than that found in the prior U.S. application(s) identified in paragraph C.
- E. ☒ The present international application ☒ contains additional subject matter not found in the prior U.S. application(s) identified in paragraph C. above. The additional subject matter is found on pages 3-9 and 11-13 and ☒ DOES NOT ALTER ☐ MIGHT BE CONSIDERED TO ALTER the general nature of the invention in a manner which would require the U.S. application to have been made available for inspection by the appropriate defense agencies under 35 U.S.C. 181 and 37 CFR 5.1. See 37 CFR 5.15

III. ☐ A Response to an Invitation from the RO/US. The following document(s) is (are) enclosed:

- A. ☐ A Request for An Extension of Time to File a Response
- B. ☐ A Power of Attorney (General or Regular)
- C. ☐ Replacement pages:

pages		of the request (PCT/RO/101)	pages		of the figures
pages		of the description	pages		of the abstract
pages		of the claims			

- D. ☐ Submission of Priority Documents

Priority document		Priority document	
-------------------	--	-------------------	--

- E. ☐ Fees as specified on attached Fee Calculation sheet form PCT/RO/101 annex

IV. ☐ A Request for Rectification under PCT 91 ☐ A Petition ☐ A Sequence Listing Diskette

V. ☐ Other (please specify):

The person signing this form is the:

- ☐ Applicant
- ☒ Attorney/Agent (Reg. No.)
- ☐ Common Representative

Michael A. Sanzo

Typed name of signer

Signature

09/486613

U.S. Application No. (if known) See 37 C.F.R. 1.50):  
 International Application No. PCT/US98/18284

430 Rec'd PTO 29 FEB 2000

Page 2  
 Atorney's Docket No: HDC N08-002

17. X The following fees are submitted:

						CALCUL- ATIONS	PTO USE ONLY
<b>BASIC NATIONAL FEE [37 CFR 1.492(a)(1)-(5)]:</b>							
<u>X</u>	Search Report has been prepared by the EPO or JPO	\$	840.00				
—	International preliminary examination fee paid to USPTO [37 CFR 1.482]	\$	670.00				
—	No International preliminary examination fee paid to USPTO [37 CFR 1.482] but International search fee paid to USPTO [37 CFR 1.445(a)(2)]	\$	690.00				
—	Neither International preliminary examination fee [37 CFR 1.482] nor International search fee [37 CFR 1.445(a)(2)] paid to USPTO	\$	970.00				
—	International preliminary examination fee paid to USPTO [37 CFR 1.482] and all claims satisfied provisions of PCT Article 33(1)-(4)	\$	96.00				
<b>ENTER APPROPRIATE BASIC FEE AMOUNT</b>						\$970.00	
Surcharge of \$130.00 for furnishing the oath or declaration later than <u>X</u> 20 30 months from the earliest claimed priority date [37 CFR 1.492(e)]						\$130.00	
	Claims	Number filed	Number extra	Rate			
	Total Claims (Prel.Amd)	24 -20=	4	x \$ 18. =	\$ 72.00		
	Indep. Claims	5 - 3=	2	x \$ 78. =	\$ 156.00		
	Multiple Dependent Claim(s) (if applicable) + \$ 260. =				\$		
TOTAL OF ABOVE CALCULATIONS =						\$1328.00	
Reduction by 1/2 for filing by small entity, if applicable. Verified Small Entity Statement must be filed. [Note 37 CFR 1.9, 1.27, 1.28]						- \$ 664.00	
SUBTOTAL =						\$ 664.00	
Processing fee of \$130.00 for furnishing the English Translation later than 20 30 months from the earliest claimed priority date [37 CFR 1.492(f)]						\$	
TOTAL NATIONAL FEE =						\$ 664.00	
Fee for recording the enclosed assignment [37 CFR 1.21(h)] The assignment must be accompanied by an appropriate cover sheet [37 CFR 3.28, 3.31]. \$40.00 per property						+ \$	
TOTAL FEES ENCLOSED =						\$ 664.00	
(AMOUNTS TO BE REFUNDED OR CHARGED)						REFUNDED \$	
						CHARGED \$	

a) ✓ A check in the amount of **\$664.00** to cover the above fees is enclosed.

b) — Please charge my Deposit Account No. **04-0838** in the amount of \$ to cover the above fees. A duplicate copy of this sheet is enclosed.

c) ✓ The Commissioner is hereby authorized to charge any additional fees which may be required, or credit any overpayment to Deposit Account No. **04-0838**. A duplicate copy of this sheet is enclosed.

**NOTE:** Where an appropriate time limit under 36 CFR 1.494 or 1.495 has not been met, a petition to revive [37 CFR 1.137(a) or (b)] must be filed and granted to restore the application to pending status.

**SEND ALL CORRESPONDENCE TO:**

Henry D. Coleman, Esq.  
 Coleman Sudol, LLP  
 708 Third Avenue  
 New York, NY 10017  
 Tel. (212) 679-0090

Henry D. Coleman  
 Name

signature

32,559  
 Reg. No.

February 29, 2000  
 Date

# Vinson & Elkins

ATTORNEYS AT LAW

VINSON & ELKINS L.L.P.  
THE WILLARD OFFICE BUILDING  
1455 PENNSYLVANIA AVE., N.W.  
WASHINGTON, D.C. 20004-1008  
TELEPHONE (202) 639-6500  
FAX (202) 639-6604

WRITER'S TELEPHONE  
(202) 639-6585

April 20, 1999

*Via Federal Express*

International Searching Authority  
European Patent Office  
P.B. 5818 Patentlaan 2  
NL-2280 HV Rijswijk  
THE NETHERLANDS

RE: Response to Invitation to Pay Additional Fees  
Appl. No.: PCT/US98/18284  
Filed: 3 September 1998  
For: **Noribogaine in the Treatment of Pain  
and Drug Addiction**  
Applicant: NovoNeuron, Inc., *et al.*  
Atty. Dkt.: NOV550/58000

Dear Sir:

The following documents are forwarded herewith for appropriate action by the International Searching Authority:

1. Response to Invitation to Pay Additional Fees;
2. A draft in the amount of 4,396.70 DEM representing the fee for two additional searches; and
3. One return postcard.

It is respectfully requested that the attached postpaid postcard be stamped with the date these documents were received by the ISA and returned as soon as possible.

Respectfully submitted,

VINSON & ELKINS L.L.P.

*Michael A. Sanzo*

Michael A. Sanzo  
Attorney for Applicant  
Registration No. 36,912

MAS:ct  
Enclosures

## IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:

NovoNeuron, Inc., *et al.*

Intl. Appl. No. PCT/US98/18284

Intl. Filing Date: 3 September 1998

For: **Noribogaine in the Treatment of  
Pain and Drug Addiction**

Authorized Officer: V. Baillou

Atty Docket: NOV550/58000

**Response to Invitation to Pay Additional Fees**

International Searching Authority  
(European Patent Office)  
P.B. 5818  
Patentlaan 2  
NL-2280 HV Rijswijk  
THE NETHERLANDS

Sir:

In response to the Invitation to Pay Additional Fees mailed by the International Searching Authority on March 10, 1999, Applicants hereby elect to pay the additional fees to have a search performed on all of the claims in the application. The International Searching Authority has established that three separate inventions are present. A search has been conducted on the first invention represented by claims 1-9. The fees included herewith are for the examination of the invention of Group 2, represented by claims 10-18, and for the examination of Group 3, represented by claims 19-24.

NovoNeuron, Inc., *et al.*  
PCT/US98/18284

If, for any reason, the International Searching Authority concludes that it still cannot conduct a search on all of the claims in the present application, it is respectfully requested that Applicants' undersigned attorney be contacted in the United States at (202) 639-6585.

Respectfully submitted,

VINSON & ELKINS L.L.P.



Michael A. Sanzo  
Attorney for Applicants  
Registration No. 36,912

Date: April 20, 1999

2300 First City Tower  
1001 Fannin  
Houston, TX 77002-6760  
(202) 639-6585

# Gill Jennings & Every

European Patent Attorneys  
European Trade Mark Attorneys

Broadgate House · 7 Eldon Street · London EC2M 7LH

Tel: +44 (0)20 7377 1377  
Email: gje@gje.co.uk

Fax (Gp3): +44 (0)20 7377 1310  
(Gp4): +44 (0)20 7377 6036

The European Patent Office  
Erhardtstrasse 27  
D-80298 Munich  
Germany

P A JACKSON  
M J BRUNNER  
R A BLUM

P R B LAWRENCE  
R E PERRY  
H M M JONES  
C J HUCKER

S N RACKHAM  
R E SKONE JAMES  
P W HARRIS  
S HALEY

M V GORDON  
C A WOLFE

L A SAMUELS  
A J SMITH

A L MACQUARRIE

Accounts A J SHIAFKOU  
Formalities N D STANTON

Computer Systems G G AMABILINO  
G M ALDERMAN J M TAYLOR

09/486613

430 Rec'd PCT/PTO 29 FEB 2000

15th December 1999

COPY

Dear Sirs

International Patent Application No. PCT/US98/18284  
NovoNeuron, Inc., et al  
Our Ref: REP06002EP

The Written Opinion dated 01.12.99 is not only considerably overdue, but also incomplete. It considers claims 1-9 only, and indicates that the Applicants have "neither restricted nor paid additional fees". As will be apparent from the enclosed statement, two additional preliminary examination fees were paid on 31st August, in response to the Invitation dated 04.08.99.

Therefore, although the Applicants do not intend to make any amendment to the specification, in the international phase, I ask that the International Preliminary Examination Report is now issued, and refers to all claims.

Please date-stamp and return the attached Form 1037 to me, as acknowledgement of receipt.

Yours faithfully  
GILL JENNINGS & EVERY

R E Perry  
(Named Representative)



Text for Form PCT/IB/345  
Guinea-Bissau

On 08 May 1998 (08.05.98), Guinea-Bissau deposited its instrument of accession to the Bangui Agreement establishing the African Intellectual Property Organization (OAPI), and as from 08 July 1998 (08.07.98), the date on which it became bound by that Agreement, it will be possible for PCT applicants to designate Guinea-Bissau for an OAPI patent. Furthermore, as from 08 July 1998 (08.07.98), it will no longer be possible to designate Guinea-Bissau for a national patent, but rather, any designation of Guinea-Bissau in an international application filed on or after 08 July 1998 (08.07.98) will have the effect of an indication of the wish to obtain an OAPI patent.

Because the designation for an OAPI patent of any State which is party both to the PCT and to the OAPI Agreement automatically has the effect of a designation of all such States for an OAPI patent ; it is not possible to make a designation for an OAPI patent of only some of those States. Thus, the designation of Guinea-Bissau for an OAPI patent in fact results in the designation of all OAPI states for an OAPI patent.

Therefore, as explained above, the purported designation of Guinea-Bissau for a national patent has been cancelled *ex officio* by the International Bureau, and

- a. the designation "OA" has been corrected to include "GW Guinea-Bissau" in the list of States covered by that designation.
- b. the designation "OA", which was not made by the applicant, has been added.
- c. the designation "OA" including the indication "GW Guinea-Bissau" made by the applicant is maintained.

09/486613

430 Rec'd PCT/PTO 29 FEB 2000

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:

NovoNeuron, Inc., *et al.*

Intl. Appl. No. PCT/US98/18284

Intl. Filing Date: 3 September 1998

For: **Noribogaine in the Treatment of  
Pain and Drug Addiction**

Authorized Officer: J. McDowell

Atty Docket: NOV550/58000

**RESPONSE TO INVITATION TO CORRECT DEFECTS**

The Assistant Commissioner for Patents  
Box PCT  
Washington, D.C. 20231

**Attn: PCT International Division**

Sir:

This communication responds to the Invitation to Correct Defects mailed October 5, 1998, for the above-captioned International Application,

The sole error referred to in the Invitation to Correct Defects relates to Figures 1A and 1B. These were filed on a single sheet and it is alleged that they are not clearly separated from one another. In order to correct this defect, Applicants are submitting herewith a substitute sheet in which Figure 1A and Figure 1B have been separated from one another. No substantive changes were introduced into the graphs shown on the substitute sheet and no matter was either added or deleted. Since the inclusion of this substitute sheet clearly does not materially alter the application, it is respectfully submitted that it be entered in the place of its originally filed counterpart.

**Conclusion**

In view of the enclosed substitute drawings, it is respectfully requested that the authorized officer withdraw the present objections to the application and allow it to proceed to publication. If, in the opinion of the authorized officer, a phone call may expedite handling of this application, the authorized officer is invited to call Applicants' undersigned attorney at (202) 639-6585.

Respectfully submitted,

VINSON & ELKINS L.L.P.

*Michael A. Sanzo*

Michael A. Sanzo  
Attorney for Applicants  
Registration No. 36,912

Date: November 3, 1998

2300 First City Tower  
1001 Fannin  
Houston, TX 77002-6760  
(202) 639-6585